

**REMARKS**

Claims 1, 3, 5, 6, 8-16, 18 and 19 are pending in this application. By this Amendment, claims 1, 3, 5, 6 and 8-14, 16, 18 and 19 are amended. No new matter is added. Claim 17 is canceled without prejudice to, or disclaimer of, the subject matter recited in that claim. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Ruhl in the June 6, 2007 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

**I. The Claims Recite Statutory Subject Matter**

The Office Action, in paragraph 2, rejects claims 1, 3, 5, 6 and 8-19 under 35 U.S.C. §101 asserting that the claimed subject matter is allegedly directed to non-statutory subject matter. This rejection is respectfully traversed.

The Office Action alleges that Applicants' clarifying amendments made in response to rejections under 35 U.S.C. §112, second paragraph, asserted in the previous Office Action render the claims now "considered to be non-statutory because the apparatus/system claims are reciting structure to a system, and claiming the use of the recited structure in the same claim." The Office Action goes on to assert that "[t]his is a mixing of two distinct statutory classes of invention, namely apparatus and process claims." The Office Action then instructs, based on the above improper conclusion, that "[a] single claim cannot be a mix of apparatus claims and a method claim, this renders the claims as non-statutory."

While not conceding the propriety of these conclusions, and as suggested by the Examiner during the June 6 personal interview, the claims are voluntarily amended to obviate the rejection.

Accordingly, reconsideration and withdrawal of the rejection of claims 1, 3, 5, 6, 8-16, 18 and 19 under 35 U.S.C. §101 as being allegedly drawn to non-statutory subject matter are respectfully requested.

**II. The Claims Are Definite**

The Office Action, in paragraph 4, rejects claims 1, 3, 5, 6 and 8-19 under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is respectfully traversed.

Related to the above discussion, the Office Action continues in asserting that the alleged mixing of statutory classes is believed to introduce indefiniteness to the subject matter of the pending claims.

This is an overly broad construction that does not appear to give patentable weight to all of the positively recited claim features, which specify precisely the metes and bounds of the features, positively recited in the pending claims. Further, it is unclear based on the totality of the discussion on pages 3 and 4 of the Office Action whether the Examiner, in asserting some indefiniteness regarding the subject matter of the pending claims, consulted Applicants' disclosure in an effort to clarify such indefiniteness and/or ambiguity as is required.

Applicants are not suggesting that any features need be imported into the claims from the specification because the claims are definite on their face. Rather, Applicants' disclosure is instructive in specifically clarifying those features which the Office Action asserts as indefinite. The conclusions of the Office Action that "[o]ne wishing to avoid infringement would not know if infringement would occur" based on all of the assertions made in the Office Action is (1) not the standard by which definiteness of a claim should be construed under 35 U.S.C. §112, second paragraph, and (2) is not, therefore, germane to any discussion such as that set forth in the Office Action.

The test for compliance with the second paragraph requirement of 35 U.S.C. §112, as stated in *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126, (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994), is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more. This standard has clearly not been applied in the rejection of at least claims 1, 3, 5, 6 and 8-19, as stated on page 3 and at the top of page 4 in the Office Action.

Additionally, the Office Action asserts that certain features regarding, for example, the tie-up station device may not be set out in such clear and definite terms as to raise ambiguity concerns regarding the recited claims as well. Again, the above-quoted standard is not applied in attempting to render indefinite the subject matter of any of the pending claims.

Applicants' representative presented the above arguments to Examiner Ruhl during the June 6 personal interview. No agreement was reached. While not conceding the propriety of the conclusions of indefiniteness, and purely in an effort to advance prosecution of this application as suggested by the Examiner during the June 6 personal interview, the claims are voluntarily amended to obviate the rejection.

Accordingly, reconsideration and withdrawal of the rejection of claims 1, 3, 5, 6, 8-16, 18 and 19 under 35 U.S.C. §112, second paragraph, are respectfully requested.

### **III. The Claims Are Allowable Over The Prior Art**

#### **A. Kane Does Not Anticipate Claims 8-13, 16 and 17**

The Office Action, in paragraph 6, rejects claims 8-13, 16 and 17 under 35 U.S.C. §102(e) over U.S. Patent No. 6,078,850 to Kane et al. (hereinafter "Kane").

Kane teaches a management system for a vehicle having a commodity storage region and traveling along a path having a plurality of geographically-distributed commodity

replenishing station, a goal of which is to calculate commodity replenishing schedules of the vehicle based on optimizing a number of factors (Abstract). More specifically, Kane discloses a train refueling system that includes a controller on board the vehicle for storing a record of the current geographic locations of the fuel stations and the current fuel prices, and for calculating refueling schedules of the vehicle at the fueling stations based on an outfit put from each of the GPS data and the fuel sensor and a fuel price at at least some of the refueling stations (col. 2, lines 29-35).

Claim 8 recites, among other features, a receiver that is provided at a place far from the construction machine, is connected with the transmitter through a specific communication means, and is configured to receive the information relating to refueling transmitted from the transmitter of the construction machine; and a selector that is configured to (1) obtain the information relating to refueling received by the receiver and (2) select an optimum refueling station from a plurality of refueling stations based on the obtained information relating to refueling and a predetermined criteria; and a communications device that is configured to (1) obtain information relating to the refueling station selected by the selector and (2) communicate with the refueling station selected by the selector request refueling of the construction machine by the selected refueling station, wherein a refueling vehicle is dispatched by the refueling station to the construction machine to refuel the construction machine in response to the request for refueling. Independent claim 9 recites similar features.

In rejecting independent claims 8 and 9, the Office Action paraphrases the claim language and then attempts to map features allegedly disclosed in Kane to the subject matter of the pending claims. The analysis of the Office Action fails for at least the following reasons.

First, the Office Action must specifically ignore the positively-disclosed features from Kane in which the calculations, apparently alleged to correspond to the selector positively

recited in the pending claim, are accomplished on board the vehicle. The Office Action paraphrases Kane in asserting its view of what Kane can reasonably be considered to teach regarding, for example, a processor at a central station having software that the Office Action broadly asserts accomplishes all of the functions attributed to the selector, as positively recited in, for example, independent claim 8. There is no manner by which Kane can reasonably be considered to teach, or to have suggested, a selector that is associated with a receiver located at a place far from the construction machine and is configured to select an optimum refueling station from a plurality of refueling stations based on the obtained information relating to refueling and a predetermined criteria, and a communication device that ... communicates with the refueling station selected by the selector to request refueling of the construction machine by the selected refueling station.

The Office Action disregards specific information related to the communication device by simply asserting that a communication device "is inherent to Kane," filling gaps in the anticipation analysis by then simply asserting that the rest of the positively recited claim features are merely intended use. The assertions in the Office Action in this regard take an inappropriately narrow view of what reasonably can be considered to be positively recited claim features and the patentably distinct nature that must be attributed to such features. It is well settled that "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 496 (CCPA 1970). Clearly, in attempting to sweep aside positively recited claim terms as simply intended use the Office Action is not undertaking the analysis required of each of these positively recited terms.

In reviewing the anticipation standard, the Federal Circuit has stated "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375 (Fed. Cir. 2001), *cert. denied*, 122 S. Ct. 1436 (2002) (emphasis added). Additionally, other

court precedent clarifies the requirements for anticipation, stating that "the reference ... must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound with any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference" (citations omitted). The standard for anticipation is also set forth in MPEP §2131, which states that "the identical invention must be shown in as much detail as is contained in the ... claim." Further, although the same terminology need not be used, "the elements must be arranged as required by the claim." The Office Action improperly ignores these requirements for anticipation by modifying, or unreasonably overly broadly construing, certain features disclosed in Kane in attempting to render anticipated the subject matter of at least independent claims 8 and 9.

For at least the above reasons, Kane cannot reasonably be considered to teach, or to have suggested, the combinations of all of the features positively recited in claims 8 and 9. Further, claims 10-13 and 16 are also neither taught, nor would they have been suggested, by Kane for at least the respective dependence of these claims, directly or indirectly, on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 8-13 and 16 under 35 U.S.C. §102(e) as being anticipated by Kane are respectfully requested.

**B. Apsell Does Not Anticipate Claim 18**

The Office Action, in paragraph 7, rejects claim 18 under 35 U.S.C. §102(e) over U.S. Patent No. 6,292,724 to Apsell et al. (hereinafter "Apsell"). This rejection is respectfully traversed.

Apsell teaches a tracking system for a fleet of vehicles (col. 1, lines 13-23). Specifically, Apsell monitors equipment use and operating conditions (col. 1, lines 39-50). A satellite-based transponder system sends data from the equipment to a satellite (col. 1, lines 60-63, col. 2, lines 53-58, col. 3, lines 39-43).

The entire analysis provided on pages 6 and 7 of the Office Action essentially concludes that because Apsell teaches a receiver and a transmitter, Apsell can reasonably be considered to teach, or to have suggested, the combination of all of the features positively recited in claim 18. This analysis, for all of the reasons indicated in paragraph A. above, does not meet the articulated standard for a finding of anticipation of the subject matter of the pending claim.

Claim 18 positively recites a control device that is provided at a base station for controlling refueling of a construction machine, comprising: a receiver that is configured to receive information relating to a residual fuel amount transmitted from a construction machine based on a determination that the residual fuel amount is less than a specified value; and a transmitter that is configured to (1) obtain the information relating to the residual fuel amount received by the receiver, and (2) transmit information relating to a request of refueling the construction machine to a tie-up station side device provided at a tie-up station which refuels the construction machine, based on the obtained information relating to the residual fuel amount, wherein a refueling vehicle is dispatched by the tie-up station to the construction machine to refuel the construction machine in response to the request for refueling. For at least its failure to teach any reception or transmission based on any determinations as are positively recited in claim 18, Apsell cannot reasonably be considered to teach the combination of all of the features recited in this claim.

Accordingly, reconsideration and withdrawal of the rejection of claim 18 under 35 U.S.C. §102(e) are respectfully requested.

**C. Claims 1, 3, 5, 6, 14, 15 and 19 Are Not Obvious Over Apsell**

The Office Action, in paragraph 10, rejects claims 1, 3, 5, 6, 14, 15 and 19 under 35 U.S.C. §103(a) to Apsell. This rejection is respectfully traversed.

The Office Action also takes a strained approach in attempting to render obvious the subject matter of the pending claims. The liberal use of official notice in order to assert what is old and well known in the art as may be applied to the subject matter of the pending claims represents an apparent attempt to fill in voids in the obviousness analysis with conclusory statements that are provided without a requisite evidentiary basis. Even if it were true that some low fuel level alert indicator may reasonably be suggested to exist in some prior art, there is no suggestion why one of ordinary skill in the art would have been motivated to modify any feature disclosed in Apsell to include such a low fuel lever indicator as is broadly asserted, in a conclusory manner, in paragraph 10 of the Office Action.

The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (quoting *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002), and *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)). This standard is not met here as no articulated reasoning with some rational underpinning is provided.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicants respectfully submit that the rejection of at least the pending independent claims is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific evidence of a teaching, suggestion or

motivation in the prior art for one of ordinary skill to make the modifications suggested by the Office Action.

The loosely related assertions, made in a conclusory manner in the Office Action do not satisfy the articulated standard for a finding of obviousness at least for their failure to provide any objective evidence of a motivation, suggestion or teaching in the prior art to make the combinations and/or modifications asserted by the Office Action.

Claim 1 recites, among other features, a construction machine side transmitter that is provided in the construction machine and is configured to (1) obtain information relating to the residual fuel amount detected by the detector, and (2) transmit the information relating to the residual fuel amount to a base station in case when a determination is made that the residual fuel amount is less than a specified value based on the obtained information relating to the residual fuel amount. Claims 6 and 19 recite similar features. The Office Action apparently dismisses the positively recited claimed features as simply intended use. It is clear from the recitation of at least this feature of the pending claims that the construction machine side transmitter may be considered particular because it is only required to transmit certain specified information based on a determination. Despite the assertions to the contrary in the Office Action, no such transmitter or transmission capability can reasonably be considered to have been suggested by Apsell.

For at least the foregoing reasons, Apsell cannot reasonably be considered to have suggested the combinations of all of the features positively recited in at least independent claims 1, 6 and 19. Further, claims 3, 5, 14 and 15 also would not have been suggested by the applied reference for at least the respective dependence of these claims on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 1, 3, 5, 6, 14, 15 and 19 under 35 U.S.C. §103(a) as being unpatentable over Apsell are respectfully requested.

**D. Claims 8-13 And 16 Are Not Obvious Over Apsell In View Of Kane**

The Office Action, in paragraph 11, rejects claims 8-13, 16 and 17 under 35 U.S.C. §103(a) over Apsell in view of Kane. This rejection is respectfully traversed.

For the totality of the above discussion, and because there is no asserted motivation to combine the references in the manner suggested by the Office Action that would meet the above-articulated standards for such a showing, no asserted combination of Apsell and Kane can reasonably be considered to have suggested the combinations of all of the features positively recited in independent claims 8 and 9. Further, claims 10-13 and 16 also would not have been suggested by this combination of applied references for at least the respective dependence of these claims directly or indirectly on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 8-13 and 16 under 35 U.S.C. §103(a) as being unpatentable over Apsell in view of Kane, are respectfully requested.

**IV. The Response To Arguments In The Office Action Mischaracterizes Applicants' Arguments and Draws Improper Conclusions**

In response to Applicants' previously-made arguments, the Office Action asserts that transmitters and/or receivers (or communications devices) with all the features positively recited in the pending claims can reasonably be considered to at least be suggested by the applied references. The Office Action asserts that Applicants' previous arguments over the rejections of the pending claims are not persuasive because, again here, the Office Action makes the assertion that the positively recited claim features are alleged to only refer to

intended manners of using the recited components within the individual systems. The prior art in fact does not disclose what is claimed "as far as an apparatus goes" when each of the positively recited claim features, and each term recited in the pending claims is given its ordinary and plain meaning and is further properly construed. As the Office Action correctly asserts, the currently pending claims are not method claims.

With regard to the second paragraph provided as a response to Applicants' previously-asserted arguments, it is improper to conclude that, because the previous Office Action failed to carry its burden in rendering anticipated and/or obvious the subject matter of the pending claims and Applicants challenged those rejections on reasonable grounds, any specific assertion from the previous Office Action that Applicants deemed unnecessary to individually address is either taken as proper, or "agreed to," by the Applicants. This is not the case.

The previous Office Action failed, in Applicants' opinion as argued, to meet its burden of showing all of the features positively recited in the claims, particularly as amended, to be taught, or even to have been suggested, by any permissible combination of the applied references. Applicants' specific traversal of the prior art rejections set forth in the previous Office Action is necessary only to a degree to appropriately traverse those rejections. The totality of Applicants' arguments, as set forth in the January 8 Amendment, adequately meet this requirement and no further inference can be made regarding Applicants' intended response.

During the June 6 personal interview, Applicants' representative attempted to discuss the applicable standard with Examiner Ruhl. The Examiner was (1) clear in an interpretation of 37 C.F.R. §1.111 that Applicants do not believe is supported by the plain language of the Rule, and (2) when challenged, clear in his unwillingness to review his construction. The Examiner, in response to Applicants' representative seeking clarification regarding the above assertions in the Office Action, indicated that he interpreted the provisions of Rule 111 that

an Applicant's response specifically point out the supposed errors in the Examiner's action to mean that the response must point out all of the supposed errors, *i.e.*, every error that the Applicant perceives having been raised in the Office Action, at the risk of errors not specifically addressed in the response being deemed "agreed to" by the Applicant.

This construction of Rule 111 imputes a standard that is (1) not explicitly stated, (2) contrary to any interpretation of which Applicants' representative is otherwise aware, and (3) is not supported by the language of the Rule taken in its entirety. Rule 111 states, in pertinent part, "[t]he reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action." The distinct use of the qualifiers "the" with respect to the supposed errors, and "every" with respect to the grounds, clearly indicates an intent that "the" not be read as "every" or "all of" with respect to the supposed errors, or else the Rule would clearly state "every supposed error..." in the same manner that it states "every ground of objection and rejection...."

**V. Conclusion**

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3, 5, 6, 8-16, 18 and 19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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JAO:DAT/cfr

Attachment:  
Petition for Two-Month Extension of Time

Date: June 29, 2007

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